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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,541	11/29/2001	Derek Forbes	ACO6194US	7266

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EXAMINER

TSOY, ELENA

ART UNIT	PAPER NUMBER
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1762

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DATE MAILED: 01/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/997,541

Applicant(s)

FORBES ET AL.

Examiner

Elena Tsoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: _____

Specification

1. The disclosure is objected to because:

(a) it contains expressions that appear to be a literal translation into English from a foreign document such as "non-like", "its like", "like components", "like hardeners", "like binders", etc. Appropriate translation is required.

(b) the use of underlining in disclosure (See pages 12, 14, 15, 17) fails to conform with current U.S. practice and would be confusing during publishing. Appropriate correction is required.

Claim Objections

2. Claims 1, 8 are objected to because of the following informalities:

Claim 1, lines 3, 11, "at least two non-like components" appears to be a literal translation into English from a foreign document. The phrase is advised to change to -- at least two components --. The use of "non-like" is not necessary because "at least two components" chosen from different components A, B, and C would be different inherently.

Claim 1, lines 8-10, the phrase "at least one component being a binder or hardener, such component having different reactivity from its like component A or B" appears to be a literal translation into English from a foreign document. The phrase is advised to change to -- at least one component being a binder having different reactivity from the component A or hardener having different reactivity from the component B --.

Claim 8, lines 1-4, the phrase "component C is a binder having a different reactivity from its like component A or B and component D is a hardener having different reactivity from its like component A or B" appears to be a literal translation into English from a foreign document. The

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phrase is advised to change to -- component C is a binder having a different reactivity from the component A and component D is a hardener having different reactivity from component B --.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform to current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim 1, lines 3-10, a phrase "choosing at least two non-like components for the coating composition from components in the plural component apparatus; the plural component apparatus having (A) at least one binder component, (B) at least one hardener component, and (C) at least one component being a binder or hardener, such component having different reactivity from its like component (A) or (B)" renders the claim indefinite because the phrase may be interpreted in such a way that the coating composition may be formed from two hardener components having different reactivity without the use of a binder. For examining purposes the phrase was interpreted as -- "choosing at least two different components for the coating composition from components in the plural component apparatus; the plural component apparatus having (A) at least one binder component, (B) at least one hardener component, and (C) at least one component being a binder or hardener, such component having different

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reactivity from component (A) or (B); so that the coating composition comprises at least one binder and at least one hardener --.

Claim 3, line 2, the terms "slow" and "fast" are relative terms, which render the claim indefinite. The terms are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The specification as filed discloses that the invention relates to the use of fast hardener and a slow hardener (See specification as filed, page 8, paragraph 2) and gives examples of fast and slow hardeners such as Autocryl® Rapid Hardener for fast hardener and Autocryl® Hardener for a slow hardener (See specification as filed, page 11, examples).

Therefore, it is not clear from specification as filed what ranges are intended to be encompassed by these terms.

Claim 5 recites the limitation " the volume percentage of component the shared component " in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 5, line 2, a phrase "the volume percentage of component the shared component" renders the claim indefinite because the meaning of the phrase is not clear. For examining purposes the phrase was interpreted as -- a volume percentage of the component A --.

Claims 5 and 6, each claim recites the limitation "the shared component" in line 2. There is insufficient antecedent basis for this limitation in the claims. For examining purposes the phrase was interpreted as -- the component A --.

Claim 6 recites the limitation " the volume percentage of the shared component " in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "the shared component" in line 4. There is insufficient antecedent basis for this limitation in the claims.

Claim 7 recites the limitation "said substrate" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 7, lines 1-7, "wherein said substrate is a vehicle surface panel with said coating composition comprising a primer to be applied as an external coating to said panel, with there being a first component (A) comprising a binder (the shared component), and there being at least one of a second component (B) and third component (C), B comprising a sanding hardener and C comprising a wet-in-wet hardener, the volumetric ratio of A to B+C ranging from 100:80 to 100:60" renders the claim indefinite because it is confusing, e.g., it is not clear whether said coating composition comprises a primer or applied as a primer, etc. For examining purposes the phrase was interpreted as -- wherein said coating composition is applied to a vehicle surface panel as a primer, said primer comprising a sanding hardener as the component B and a wet-in-wet hardener as component C with the volumetric ratio of A to B+C ranging from 100:80 to 100:60 --.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. **Claims 1-7** are rejected under 35 U.S.C. 102(b) as being anticipated by Larson et al (US 5,260,101).

As to claims 1, 4, Larson et al disclose a process for making and applying a coating composition using a plural component apparatus (See Abstract) comprising choosing a binder (A) such as hydroxy, amine, amide functional resins, and a hardener (B) such as a hardener containing isocyanate groups (See column 10, lines 3-30), selecting a mixing ratio for (A) and (B) (See column 4, lines 61-63), mixing the components of the coating composition and applying the coating composition with the plural component apparatus (See column 4, lines 62-67); whereby a plurality of coating compositions with varying properties can be made and applied from the components in the plural component apparatus (See column 9, lines 31-35, 49-65).

The Examiner Note: the component (C) is *optional* since claim recites "choosing at least **two** different components for the coating composition from components in the plural component apparatus".

As to claim 2, the coating composition dries and cures at temperatures ranging from about ambient to 80 °C (68 °F-176 °F) (See column 2, lines 63-64).

As to claim 3, limitations of claim 3 are not addressed because the component (C) is *optional*.

As to claims 5-7, the coating composition may have various VOC levels in response to various dry time and cure time needs, for example for spot repair versus overall repair (See column 9, lines 49-52) including 3.5 lb/gal (about 46 vol.%) VOC coating compositions, i.e., having at least 5-10 volume % of the component A; said coating composition might be used as a

primer or clearcoat (See column 11, lines 30-38; claim 5). The volumetric ratio of A to B+C ranging from 100:80 to 100:60 is not addressed since the component (C) is *optional*.

It is the Examiner's position that a hardener in the coating composition of Larson et al is a sanding hardener *inherently* since the coating composition of Larson et al is substantially identical to that of claimed invention.

It is held that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, claimed properties or functions are presumed to be inherent. See MPEP 2111.02, 2112.01. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 3, 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Larson et al (US 5,260,101).

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Larson et al, as applied above, further teach that both aromatic and aliphatic diisocyanates may be used as hardeners (See column 10, lines 11-19). It is well known in the art that aromatic and aliphatic diisocyanates have different reactivity toward OH-groups, as evidenced by Vu (US 4,710,560). However, Larson et al fail to teach that the coating composition comprises a combination of aromatic and aliphatic diisocyanates (hardeners having different reactivity, the aromatic diisocyanates being faster than aliphatic ones), i.e., further comprises a hardening component C (Claim 3) or D (Claim 8) having a different reactivity from the hardening component B.

It is held that it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). See also In re Crockett, 279 F.2d 274, 126 USPQ 186 (CCPA 1960); and Ex parte Quadranti, 25 USPQ2d 1071 (Bd. Pat. App. & Inter. 1992).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used combination of aromatic and aliphatic diisocyanates as hardeners in a coating composition of Larson et al since each of aromatic and aliphatic diisocyanates is useful for the same purpose, as taught by Larson et al.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (703) 605-1171. The examiner can normally be reached on 9:00-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Elena Tsoy

Elena Tsoy
Examiner
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January 16, 2003